

Remarks

Claims 1, 4-8, 10 and 12-15 are pending.

After-Final Amendment

Applicant requests entry of the above amendment to Claims 4 and 7 to correct a scrivener's error. The "and" between the first and second additional claim elements should have been deleted when the third element was added in the prior amendment. The amendment does not touch the merits of the case.

Rejections Based On Baggarly and Vogel

All pending claims stand rejected under Section 103 as being obvious over Baggarly 4639873 in view of Vogel 5914464. For the reasons detailed below, the Office has failed to show that the combination of Baggarly and Vogel teaches or suggests all claim limitations or that the combination is properly motivated. The Office has, therefore, failed to establish a *prima facie* case of obviousness.

The Office Fails To Show The Combination Teaches Or Suggests All Claim Limitations

Claim 1 recites "determining the number of sheets in the parcel based on a relationship between the thickness of the parcel and the number of sheets in the parcel." The Office asserts that Baggarly teaches this element at column 3, lines 45-55. This assertion is not correct. Baggarly teaches counting "the number of documents fed from the fast feeder for each machine cycle." Baggarly column 3, lines 49-50. Even if it is assumed for purposes of argument only, and without conceding, that counting "the number of documents fed from the fast feeder for each machine cycle" in Baggarly constitutes determining the number of sheets in a parcel, that determination is not made "based on a relationship between the thickness of the parcel and the number of sheets in the parcel." The Office has failed to show that Baggarly teaches any relationship between the thickness of a parcel and the number of sheets in a parcel from which the number of sheets in the parcel might be determined. Indeed, no such relationship is needed in Baggarly because he simply counts the number of sheets inserted into the parcel (if the assumption noted above is correct).

Claim 1 also recites "accessing weight data for ... the packaging" and "determining the weight of the parcel based on the ... weight data accessed for ... the packaging." The Office asserts Baggarly teaches these elements at column 23, lines 54

through column 24, line 10. This assertion is not correct. There is no mention of any kind of packaging at all in this passage in Baggarly. The Office seems to have ignored completely the packaging elements of Claim 1.

The same analysis applies to Claims 6, 10 and 15 which recite limitations similar to those of Claim 1 (and the Office cites to the same passages in Baggarly as teaching those limitations). For these same reasons, therefore, the Office has failed to establish a *prima facie* case of obviousness as to Claims 6, 10 and 15. [Claim 6 recites "accessing weight data for ... different types of envelopes", "determining the number of sheets in the parcel based on a relationship between the thickness of the parcel and the type of print media in the parcel" and "computing the weight of the parcel based on the ... weight data accessed for ... the envelope." Claim 10 recites "accessing weight data for ... different types of envelopes" and "computing the weight of the parcel based on the accessed weight data and the detected thickness and scanned size of the parcel." Claim 15 recites computer instructions to "access weight data for parcel ... packaging" and to "compute the weight of the parcel based on the received thickness data and the accessed weight data."]

The Office Fails To Show Proper Motivation To Combine The References

The Office acknowledges that Baggarly does not teach detecting the thickness of a parcel. Vogel teaches detecting the thickness of a parcel. The Office apparently asserts it would have been obvious to combine this teaching from Vogel with Baggarly to arrive at the claimed invention — the Office states that "[i]t would have been obvious ... to detect the thickness of a parcel ... with the motivation of determining the postage fee based on the thickness of the parcel."

Obviousness can only be established by combining the teachings of the prior art where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Office must rely on objective evidence and make specific factual findings with respect to the motivation to combine references. MPEP § 2143.01.

The Office has not cited to any evidence at all in support of the asserted motivation to combine Vogel and Baggarly. For this reason alone, the Office has failed to carry its burden of establishing a *prima facie* case of obviousness. In fact, there is no

motivation to combine Vogel and Baggally. In Vogel, the thickness of the parcel is measured to determine compliance with postal regulations establishing the maximum allowable parcel thicknesses. Vogel, column 5, lines 43-51. There is nothing in Vogel that even remotely suggests detecting thickness to determine the number of sheets in the parcel or making any other determination related to postage. Baggally does not even mention the thickness of a parcel – "thickness" does not appear anywhere in Baggally.

Clearly, there is nothing in the references themselves that motivates the combination. Therefore, the only way the Office can continue to rely on the combination of Baggally and Vogel is to make "specific factual findings" supported by "objective evidence" of knowledge generally available to one of ordinary skill in the art motivates the combination. Absent such a showing, the rejections should be withdrawn.

Metal Binder – Claims 4, 7 and 13

Claim 4 recites detecting a metal binder in a parcel, accessing weight data for the metal binder and determining the weight of the parcel based on the metal binder. Claim 7 recites similar limitations. Claim 13 recites a metal detector and a computer configured to compute the weight of the parcel based on metal data received from the metal detector.

The Office presents an interesting and varied analysis rejecting the further limitations of Claims 4, 7 and 13. For Claims 4 and 13, the Office argues the metal binder and metal detector limitations "[amount] to the recitation of non-functional data; the type of claim has no bearing on the invention as claimed, and thus [carry] no patentable weight", but that these limitations would have been obvious in any event. Office Action, pages 4-5 and 10-11. For Claim 7, the Office takes official notice that the metal binder limitations are old and well known in the parcel packaging art and that detecting a metal binder to determine weight would have been obvious. Office Action, page 7.

Non-Functional Data. The Office's reference to non-functional data is misplaced. It seems clear that the acts of detecting a metal binder, accessing weight data for the metal binder and determining the weight of the parcel based on the metal binder are clearly not "non-functional." Similarly, metal detectors and computers are highly

functional. In addition, the acts recited in Claim 4 and the structures recited in Claim 13 can hardly be considered as any kind of "data." Hence, the reference to non-functional data is inapplicable on its face to the further limitations of Claims 4 and 13.

If the Office persists in the "non-functional data" rejection of Claims 4 and 13, it is respectfully requested to specifically explain how the acts recited in Claim 4 and the structures recited in Claim 13 might reasonably be deemed to be both non-functional and data, and to cite to relevant legal authority that supports the application of the concept of "non-functional data" to these types of method claims and device claims.

Obviousness. With regard to obviousness, the Office is apparently asserting that it would have been obvious to modify the combination of Baggally and Vogel to add the further limitations of Claims 7 and 13. Any such assertion is not correct. First, the Office has made no showing whatsoever that either Baggally or Vogel teach or suggest any of the further limitations recited in Claim 7 or in Claim 13. The assertion at pages 4 and 10 of the Office Action that a metal binder is somehow inherent in Baggally because "informational disclosures and advertising enclosures ... tend to have more than one page that need to be bind [sic] together" is wholly without merit.

From a factual standpoint, the assertion is purely speculative. The Office has not cited to any language in Baggally from which it might be inferred that the sheets inserted into a package must be bound, in general, and more specifically, that the sheets are bound with a metal binder.

From a legal standpoint, the Office has completely failed to meet the test of inherency. To establish inherency, the Office must show that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP § 2112, paragraph IV. The Office has not, as yet, made the required showing.

Second, the Office has failed to show proper motivation to modify the combination of Baggally and Vogel. The Office asserts (1) the act of detecting a metal binder is motivated by stuffing the package with a single lengthy information/advertising

insert and (2) determining the weight of the parcel based on the metal binder is motivated by determining the weight of the parcel based on the items inserted into the customer's envelope.

Obviousness can only be established by modifying the teachings of the prior art where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Office must rely on objective evidence and make specific factual findings with respect to the motivation to modify references. MPEP § 2143.01. The Office is not free to speculate on motivation, or to invent advantages it perceives might flow from the modification. The law requires that the Office **PROVE** motivation to modify by producing evidence that supports its findings. The Office has not, as yet, offered any evidence whatsoever that supports either of the two motivations advanced to support the modification of Baggally and Vogel.

In fact, there is no motivation to modify the combination of Vogel and Baggally. In Vogel, the thickness of the parcel is measured to determine compliance with postal regulations establishing the maximum allowable parcel thicknesses. Vogel, column 5, lines 43-51. There is nothing in Vogel that even remotely suggests detecting metal binders in the parcel for any purpose, specifically not for determining weight or postage. Baggally does not mention any kind of binder – "binder" does not appear anywhere in Baggally.

Clearly, there is nothing in the references themselves that motivates the modification to the combination. Therefore, the only way the Office can continue to rely on the modification to the combination of Baggally and Vogel is to make "specific factual findings" supported by "objective evidence" of knowledge generally available to one of ordinary skill in the art motivates the modification. Absent such a showing, the rejection should be withdrawn.

Official Notice. The Office has taken official notice that "it is old and well known in the parcel packaging art to detect a metal binder in a parcel, and to determine the weight of the parcel based on the metal binder." Applicant respectfully requests that the Office support this finding with objective evidence in accordance with MPEP 2144.03. While it might have been old and well known to weigh a parcel that includes a metal

binder (and thereby determine the weight of the parcel), it is highly doubtful that it was either old or well known to detect a metal binder in a parcel and then determine the weight of the parcel based on the metal binder that was detected as having been in the parcel. So far as Applicant is aware, the further limitations added by Claim 7 are novel.

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

/Steven R. Ormiston/

Steven R. Ormiston
Reg. No. 35,974
208.433.1991 x204